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JGJR.: 03-07

Paper No: \_\_\_\_

GUDRUN E. HUCKETT DRAUDT  
LONSSTR. 53  
WUPPERTAL 42289 DE GERMANY

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**APR 23 2007**

**OFFICE OF PETITIONS**

In re Application of  
Ehwald, et al.  
Application No. 09/865,338  
Filed: 28 May, 2001  
Attorney Docket No. 010462  
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ON PETITION

This is a decision on the petition (renewed) filed on 3 July, 2006, to revive the above-identified application alleging unintentional delay under 37 C.F.R. §1.137(b)

For the reasons set forth below, the petition under 37 C.F.R. §1.137(b) is **GRANTED**.

**BACKGROUND**

The record reflects that:

- Petitioner failed to reply timely and properly to the non-final Office action mailed on 25 September, 2002, with a reply due absent an extension of time on or before 26 December, 2002;
- as a result, the application went abandoned by operation of law after midnight 26 December, 2002;
- the Office mailed the Notice of Abandonment on 6 May, 2003;
- other than a single financial transaction in January, 2003, there is no indication that the

former Counsel took any action regarding this matter until the filing of a Status Inquiry on 12 January, 2006—nearly thirty-seven (37) month after abandonment and thirty-two (32) months after Notice of Abandonment was mailed;

- in the original petition (with fee authorization), there was only an averment of s what already was known and provided no documentary evidence in support, and so the petition was dismissed on 6 March, 2006;
- while the first renewed petition (4 April, 2006) was accompanied by the fee and the reply, but the statement of unintentional delay was not made by the former Counsel under whose handling the application went abandoned, or by the Applicant—and so the person making the statement lacked the knowledge of the facts that would permit him to do so, and so the petition was dismissed on 5 June, 2006;
- the instant petition sought to and did correct that defect.

### STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>1</sup>

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.<sup>2</sup> Delays in responding properly raise the question whether delays are unavoidable.<sup>3</sup> Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37

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<sup>1</sup> 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

<sup>2</sup> Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

<sup>3</sup> *See: Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

C.F.R. §1.137(a).<sup>4</sup>

And the Petitioner must be diligent in attending to the matter.<sup>5</sup> Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>6</sup>))

As to the Allegation  
of Unintentional Delay

The requirements for a grantable petition under 37 C.F.R. §1.137(b) are the petition and fee, a statement/showing of unintentional delay, a proper reply, and—where appropriate--a terminal disclaimer and fee if the application was filed before 8 June, 1995.

The record (including the petitions filed on 6 February, 4 April and 3 July, 2006) does not necessitate a finding that the delay between midnight 26 December, 2002 (date of abandonment), and 3 July, 2006 (date of filing of grantable petition), was not unintentional.

Rather, the Patent and Trademark Office is relying in this matter on the duty of candor and good faith of Petitioners Ehwald, Ehwald, Knoll, Winkler and Zinke and Counsel Gudren E. Hockett, Ph.D. (Reg. No. 35,747) when accepting Petitioners' representation that the delay in filing the response was unintentional.<sup>9</sup>

Petitioner has satisfied the regulatory requirements.

CONCLUSION

The instant petition under 37 C.F.R. §1.137(b) is **granted**.

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<sup>4</sup> See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

<sup>5</sup> See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

<sup>6</sup> Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared and/or deposited for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely prepared and/or deposited for shipment.

<sup>9</sup> See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 C.F.R. §1.137(b) to the Patent and Trademark Office).

The application is released to Technology Center 2800 for further processing in due course.

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2<sup>1</sup>) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).



John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions

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<sup>1</sup> The regulations at 37 C.F.R. §1.2 provide:

**§1.2 Business to be transacted in writing.**

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.